

Snap-On v. Milwaukee Electric Tool Corp: Order Authorizing Application for Subpoena to Obtain Discovery from Non-Party IPR2015-01242, -01243, -01244

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Takeaway: A non-party's agreement to produce requested discovery within the schedule of the proceeding and an indication as to the lack of burden on the non-party is likely persuasive to the Board when deciding whether to authorize a party's application for a subpoena.

In its [Order](#), the Board addressed matters that had been discussed during a consolidated conference call with the parties. Initially, the Board ordered the parties to jointly file a public version of Exhibit 3001, which was filed under seal. The Board then addressed Petitioner's request for permission to seek additional discovery with respect to several items.

Petitioner requested "authorization to compel routine discovery or, in the alternative, to file a motion for additional discovery of the Shampine Deposition Transcript," which had been filed under seal in another IPR. However, as Patent Owner noted, a public version of the document had been filed. Petitioner was unaware of the public version, and therefore, withdrew its request.

Petitioner sought "authorization to file a motion for additional discovery of documents allegedly bearing on Patent Owner's assertions of secondary considerations," which were also filed under seal. Patent Owner agreed to produce the requested documents on the condition that Petitioner abandon its request for other documents, arguing that Petitioner had been taking unreasonable discovery positions. The Board ordered Patent Owner to produce the requested documents without any conditions.

With respect to documents "that allegedly relate to conception and reduction to practice of the invention by persons other than the named inventors," the Board decided that further briefing was necessary to determine if "something useful will be found." Thus, the Board granted Petitioner authorization to file a motion for additional discovery.

Petitioner also requested production of documents related to a specific license that "allegedly bear upon Patent Owner's contentions of secondary considerations of nonobviousness." Patent Owner did not object to producing the documents but advised the Board that a clause in the license prevented disclosure except "upon order of a court or administrative tribunal." The Board decided that production was warranted and ordered Patent Owner to produce the documents.

Petitioner sought a subpoena to obtain discovery from non-party Black & Decker as to documents that “allegedly relate to the negotiation of license agreements between Patent Owner and Black & Decker.” Petitioner contacted Black & Decker who indicated that it was willing to produce the documents, that such production would not be burdensome, and that the production could be completed expeditiously. Based on the foregoing, the Board authorized Petitioner to apply for a subpoena from a district court.

Finally, the Board authorized the parties to stipulate to an extension of Due Date 6, but reminded the parties that the date of the oral hearing (Due Date 7) would not be extended.

***Snap-On Inc. v. Milwaukee Electric Tool Corp.*, IPR2015-01242; IPR2015-01243; IPR2015-01244**

Paper 29: Order on Conduct of the Proceeding

Dated: May 12, 2016

Patents: 7,554,290 B2; 7,944,173 B2; 7,999,510 B2

Before: Grace Karaffa Obermann, Patrick R. Scanlon, and Carl M. DeFranco

Written by: Obermann

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